

## REMARKS

Applicants respectfully request consideration of the subject application.

This Amendment is submitted in response to the Office Action mailed September 12, 2005. Claims 1-27 stand rejected. With this Amendment, claims 1, 17, 21 and 25-27 have been amended.

### 35 U.S.C. § 112 Rejections

The Examiner has rejected claims 1-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 1 includes the following limitations:

wherein said advertisement has a plurality of associated selectable options that are displayed when said advertisement is displayed, further wherein each of said plurality of selectable options has an associated information delivery process, wherein the associated information delivery process differs for each of said plurality of selectable options;

(ii) receiving an indication of a selection of said one plurality of selectable options associated with said advertisement;

(iii) receiving an input from the user identifying where the information is to be sent, the input differing depending on the selection made in (ii).

Similar limitations are included in independent claims 17, 21 and 25-27.

The Examiner submits that "the content/format of the submission is entirely up to the user and cannot be determined or defined these claims which are drafted from the perspective of the server." Applicants respectfully disagree.

As shown in the embodiment illustrated in Figure 2, exemplary selectable options in an advertisement include "show more information," "email more information" and "send more information." The user selects one of these (or other) options. The input required from the user depends on which option is selected. For example, if the user selects "email more information," the server must have an e-mail address to which the information can be emailed. Thus, the input received from the user is an email address. In contrast, if, for example, the user selects "send more information," the server typically needs a home address to which the information can be sent. Thus, the input received from the user is a home address, which differs from an email address. It is clear that the input needed by the server from the user differs depending on the option selected in the advertisement and received by the server.

Although Applicants agree that a text input box is an exemplary means for receiving an input from users, Applicants respectfully submit that a text input box is not the only means for receiving an input from users.

Applicants respectfully submit that the claims particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-27 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

### 35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over Davis et al. (U.S. Patent No. 6,138,155, hereinafter "Davis") in view of Marsh et al. (U.S. Patent No. 5,848,397, hereinafter "Marsh").

#### At least one limitation is missing from the cited art:

Applicants respectfully submit the cited art fails to teach, inter alia, as claimed in claim 1: "(iii) receiving an input from the user identifying where the information is to be sent, the input differing depending on the selection made in (ii)." Similar limitations are included in independent claims 17, 21 and 25-27.

Marsh is directed to a system and method for scheduling advertisement displays. One such advertisement is a banner advertisement, which may be interactive. The user may be provided with additional information concerning the subject matter of the banner.

However, the user in Marsh has no control over how the information is delivered to the user. The only method described in Marsh for requesting additional information is e-mail. And, the input from the user does not depend on the selection made for requesting additional information because only one selection can be made in Marsh: e-mail. Moreover, the system in Marsh is off-line. Marsh teaches that it presents advertisements only when the system is off-

line or when a connection is being made to the system. See Col. 6, line 66 – col. 7, line 6.

Davis is directed to a system and method for monitoring and profiling users based on their interaction with a system. The system uses the information to create an ad banner targeted to the user. The ad banner includes a number of input mechanisms which cause events to take place in the ad banner. Providing a number of options in the ad banner is used to acquire information concerning the user's particular interests.

Davis does not teach that a user enters input at all (beyond selecting “an option” in the banner). Moreover, Davis does not teach that the input entered depends on which selectable option is selected by the user.

In contrast, in the presently claimed invention, an advertisement is served having a plurality of associated selectable options. Each of the selectable options is associated with a different information delivery process, such as, for example, email, mail and/or a link. A user selects one of these selectable options, and additional information is received from the user depending on which of the selectable options is selected by the user. The additional information requested is then sent using the process selected by the user using the information provided by the user.

Thus, as shown in the embodiment illustrated in Figure 2 and discussed above, exemplary selectable options in an advertisement include “show more information,” “email more information” and “send more information.” The user

selects one of these (or other) options, and the input required from the user depends on which option is selected. For example, if the user selects "email more information," the server must have an e-mail address to which the information can be emailed. Thus, the input received from the user is an email address. In contrast, if, for example, the user selects "send more information," the server typically needs a home address to which the information can be sent. Thus, the input received from the user is a home address, which differs from an email address. It is clear that the input needed from the user differs depending on the option selected in the advertisement.

Accordingly, Applicants respectfully submit that the cited art, alone or in combination, fails to teach such a method.

No motivation to combine the cited art:

Applicants respectfully submit there is no motivation to combine the cited art to arrive at the present invention.

The Examiner submits that Marsh's teaching for requesting information by email would motivate one to offer other well known delivery options, such as by telephone, postal mail, fax, etc., in order to offer a variety of convenient information, and that both David and Marsh teach plural interactive elements on a banner.

However, the interactive elements in Davis do not have an information delivery process associated with the interactive elements. In addition, the only

delivery option contemplated by Marsh is email, as the system is entirely offline. Neither Davis nor Marsh contemplates sending information to a user by telephone, postal mail, fax, etc. The only information Davis and Marsh contemplate providing is additional advertisements of the same type as the previous advertisement based on the user's prior interactions with the system.

As discussed above, Marsh is directed to a system and method for scheduling displays of advertisements. However, Marsh indicates that "the invention is particularly well suited for providing advertising to users of electronic mail systems while such users are not connected to an on-line network." Col. 1, lines 17-20. Marsh further indicates that "the advertisements to be shown to system users are not in any way correlated with a user's e-mail. Thus, the advertisements can be regarded as context independent. The e-mail messages come from a different source than that of the advertisements." Col. 3, lines 38-41. Marsh further indicates that: "The primary vehicle for presenting information, such as advertisements, to users during periods of off-line activity is the banner advertisement. Showcase advertisements are typically used to present information to users while a connection is being established with the server system 104 and while information including (e-mail messages and advertisements) is being transferred between the client computer 101 and the server system 104." Col. 6, line 66 – col. 7, line 6.

In contrast, the entire system in Davis is on-line. Davis provides a method and apparatus for tracking client interaction with a network so that targeted

information can be sent to particular users based on their interests and preferences. An ad banner can then be targeted to each user based on the tracking information. By providing the user with several options the system can also be used to obtain additional user preferences.

Thus, Davis is Marsh cannot be combined to arrive at a method or system in which several delivery options are offered to a user, and the user chooses the delivery.

In fact, both Davis and Marsh contemplate tracking user information to determine the information the user might desire. In contrast, the present invention specifically provides the user several choices as to additional sources of information. The user can choose to obtain the information at once, by email or by conventional delivery services. Whatever the choice, the invention is able to provide personalized responses to the user based on the user's choice in the advertisement. Thus, the website operator is able to provide the user the information he or she wants because the user selects the type of information they want to receive and how they would like to receive it by selecting an option presented in the advertisement. This can be accomplished without tracking previous interaction by the user with the system or knowing user preferences.

Thus, Applicants submit claims 1, 17, 21 and 25-27 are patentable over the cited art. As claims 2-16, 18-20 and 22-24 depend on independent claims 1, 17

and 21 respectively, claims 2-16, 18-20 and 22-24 are also patentable over the cited art.

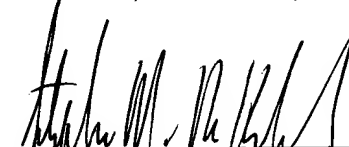
Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Marsh.

Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Stephen M. De Klerk at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



Dated: December 12, 2005

Stephen M. De Klerk  
Reg. No. 46,503

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, CA 90025-1026  
(408) 720-8300